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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 09/902,316 | 07/10/2001 | Lars Christian Herzbach | 1653 | 8443 |

7590 03/01/2004

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| EXAMINER |
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VINCENT, SEAN E

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| ART UNIT | PAPER NUMBER |
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1731

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 09/902,316 | Applicant(s) HERZBACH ET AL. | |
| | Examiner Sean E Vincent | Art Unit 1731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. The election of claims 4-9 in the response filed December 8, 2003 is acknowledged, but the elected claims were found to contain allowable subject matter. Claims 1-3 are now rejoined and new claims 10-12 are acceptable for inclusion with the rejoined method claims 1-3.

Drawings

2. New corrected drawings are required in this application because figures 1-4 are hand-drawn on a grid and it is difficult to distinguish the figure from the grid. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1-12 are indefinite because use of reference numbers in the claims confuses their scope. Considering that claims must stand on their own in delimiting the scope of the invention,

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a perceived dependence on the drawing figures raises questions regarding whether the scope is limited to the exact forms illustrated in the drawings or not. The reference numbers should be deleted.

6. Claims 1-3 are indefinite because claim 1 states "(b structuring a surface of a forming tool..." It is not clear whether the forming tool in (b is the same or different from the tool in a).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wadsworth (US 798642) in view of Giffen (US 3231356).

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10. Wadsworth taught methods of forming glass including providing a forming tool with open pores, structuring the tool according to the negative of the structure to be produced, pressing the tool into viscous glass from a melt, drawing a vacuum through the pores, and removing the tool from the glass (see figures, page 1, lines 28-40 and 59-89; page 2, lines 19-85). Wadsworth did not teach generating and overpressure on the pores to assist in the removing step. Giffen taught similar processes wherein glass was molded with the aid of suction in a mold and then air pressure was applied to eject the molded glass from the mold (see col. 3, line 59 to col. 4, line 22). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the air ejection technique from Giffen in the method of Wadsworth because Giffen taught that it would have helped to quickly remove molded glass objects from the molds.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wadsworth and Giffen as applied to claim 1 above, and further in view of Ostendarp et al (US 6128925).

12. Wadsworth and Giffen did not teach local heating of the forming tool. Ostendarp et al taught similar processes of forming glass structures wherein a forming tool is heated locally (see figure 1 and col. 4, lines 20-46). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the local heating of Ostendarp et al in Wadsworth because Ostendarp et al taught that it would allow heating the tool to operating temperatures without the expense and trouble of heating the entire tool.

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Allowable Subject Matter

13. Claims 4-12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

14. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or fairly suggest a tool with a gas-impermeable operative layer applied on one surface of a porous base body such that the negative of the structure to be produced extends through the operative layer to the porous base material. It would not have been obvious to make the prior art tools in such a way or to use the tools in a forming method.

Conclusion

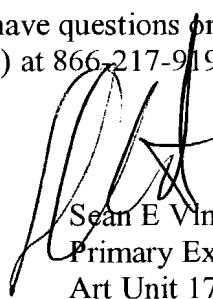
15. The prior art made of record and not relied upon is cited to further show the state of the art.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E Vincent whose telephone number is (571) 272-1194. The examiner can normally be reached on M - F (8:30 - 6:00).

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S Vincent


Sean E Vincent
Primary Examiner
Art Unit 1731